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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/731,509	12/07/2000	Thomas Schaeck	DE919990082	1249

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HESLIN ROTHENBERG FARLEY & MESITI P.C.
5 COLUMBIA CIRCLE
ALBANY, NY 12203

EXAMINER

COLIN, CARL G

ART UNIT PAPER NUMBER

2136

DATE MAILED: 12/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/731,509

Applicant(s)

SCHAECK ET AL.

Examiner

Carl Colin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16-47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 16-47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 December 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. In response to communications filed on 9/23/2005, the following claims 16-47 are presented for examination.

2. Applicant's arguments, pages 2-6, filed on 9/23/2005, with respect to the rejection of claims 16-47 have been fully considered, but they are not persuasive. Applicant states that the section column 4, lines 18-46 of Finley is read by Applicant as teaching the use of PIN/Password in addition to checking for trusted association for the trusted association between the cards. Examiner disagrees. As indicated previously in the last Office Action, Finley clearly teaches that a system operator or sponsor can create different levels of securities between different applications or databases on User's Card during normal card use. If access to one database associated with a particular application is not authorized the access card remains unusable until the correct PIN is entered. Finley recited "Depending on the applications or requirements of the system sponsor", meaning security requirements as discussed above (see also column 4, lines 5-54, "access card remains unusable until the correct PIN is entered". This shows how access cards can control addition, modification, of applications as well as database information on User cards. Also, another scenario disclosed by Finley is: if the card expires (that meets the recitation of no security association), the card can be reactivated by the system sponsor or operator (that meets the recitation of involving card holder verification). Therefore, Examiner asserts that Finley suggests user intervention when no trusted association between the cards is not found

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(either when the card expires OR when detecting or preventing fraud from downloading information from user cards to control different levels of security between different databases or applications on User Cards). Therefore, Finley either alone or in combination with Sloan renders obvious the claimed invention. In addition, Applicant requested Examiner to provide prior art disclosing "when a checking indicates no trusted association then involving the card holder to perform verification" the following patents disclose this well known feature US Patent 4,187,498 to Creekmore (column 6, lines 39-67) and US Patent 5,446,266 to Beuk et al. It remains the Examiner's position that claims 16-47 remain rejected under 35 USC 103.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3.1 **Claims 16-47** are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 5,979,773 to **Findley, Jr. et al** in view of US Patent 6,179,205 to **Sloan**.

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3.2 As per claims 16, 18-19, 28, 33, 34-35, 40, 41-42, and 47, Findley, Jr. et al

substantially discloses a method for controlling card holder verification comprising: checking the presence of another card or presence of checking the presence of a trusted association between at least one device and a card usable with the at least one device, for example (see column 7, lines 14-67; column 1, lines 30-38) and discloses performing card holder verification based on the checking (column 7, lines 46-58) wherein if the checking indicates the presence of the trusted association then a personal identification number of the holder of the card is automatically obtained and verified without requesting information from the holder of the card (column 7, lines 14-67 and column 8, lines 50-67). **Findley, Jr. et al** substantially discloses if the checking indicates no trusted association, an error message appears but suggests that information can be added or modified during normal use of the card and in addition suggests that the card can be protected by PIN or password and the card can be used when the correct PIN is entered or if the card expired the card can be reactivated by following proper procedures as determined by the system operator (column 4, lines 5-54). **Sloan** in an analogous art discloses a smart card that contains a card identification number and associated PIN number wherein the verification process is performed by comparing card ID and PIN with corresponding data stored in the device used for verification, for example (see abstract; column 5, line 44 through column 6, lines 18-45; and column 7, lines 8-28). **Sloan** further discloses that is well known that users are required to enter PIN for verification to unlock a smart card (column 4, lines 26-38) and the card holder can be given a password that will most likely not need to memorize for normal operation. In other words if there is instance of abnormal operation such as mismatch, the user will most likely need to enter it. Therefore, it would have been obvious to one of ordinary skill in the art at the time

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the invention was made to modify the method of **Findley, Jr. et al** to ask the user to enter personal identification number to verify the holder of the card if the checking indicates no trusted association because if the reader does not read the card properly for automatic operation, the user will still be given the choice of a manual operation. As it is known in the art when a store card fails the automatic validation , the user is given another option of entering a zip code or phone number to complete the transaction. This modification would have been obvious because one skilled in the art would have been motivated to give the user another option of validation of entering a personal identification number to complete the transaction because the failure of verification might be related to a machine malfunction or any misreading of related data, thus the transaction can still be completed.

As per claim 17, Findley, Jr. et al discloses different embodiments and access control of the invention wherein one device is located in a trusted environment, for example (see column 5, lines 1-25).

As per claims 20-22, 36-38, and 43-45, Findley, Jr. et al discloses the limitation of wherein the performing card holder verification comprises automatically obtaining a personal identification number of the holder of the card and verifying the personal identification number without intervention of the holder of the card, wherein the checking comprising comparing a card identifier stored on the card with one or more card identifiers stored in the device, for example (see column 7, lines 14-67; column 2, lines 1-30 lines 35-58; column 7, lines 10-20).

As per claims 23 and 26, **Findley, Jr. et al** discloses updating a PIN/password that meets the recitation of replacing the personal identification number with another personal identification number, for example (see column 9, lines 15-40 and column 3). **Findley, Jr. et al** discloses that the smart card disclosed can also be implemented as other card application well known in the art such as pay phone or ATM, etc. **Findley, Jr. et al** further discloses that the card can even be used as a multiple access card, for example (see column 10, lines 14-30). It is very well known that the card identifier as disclosed above is associated with a personal identification number usable in card holder verification. **Sloan** also discloses card ID associated with password and the replacing or erasing of data association, for example (see column 5). Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of **Findley, Jr. et al** to provide a card identifier associated with a personal identification number usable in card holder verification as it is very well known in the art in order to personalize the user with the card so that it can be used only by authorized users. For example a bank card has an identifier associated with the user PIN or password. Another example is a cable box has at least a device identifier corresponding to a card identifier. This modification does not depart from the spirit and scope of the invention disclosed by **Findley, Jr. et al**. Claims 23 and 26 are also rejected on the same rationale as the rejection of independent claims 16, 34 and 41 above.

Claims 24-25, 27, 39, and 46 recite the same inventive concept as claims 22-23 and 26. Therefore they are rejected on the same rationale as the rejection of claims 22-23 and 26.

As per claims 29-32 Findley, Jr. et al discloses the limitation of controlling association between the at least one device and the card using a network connectable to the device, and wherein the checking is between at least one device and a plurality of cards and where in the suppressing is for a plurality of holders, for example (see figure 11).

Conclusion

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

4.1 The prior art made of record and not relied upon is considered pertinent to applicant's disclosure as the art discloses the use of cards and terminal devices with capability for storing and matching identification codes and plurality of other data and discloses many of the claimed features.

US Patents:	4,810,862 Nakano et al;	5,585,787 Wallerstein;
3,866,173 Moorman et al;	6,111,951 Guenther;	6,298,441 Handelman et al.

4.2 Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carl Colin whose telephone number is 571-272-3862. The examiner can normally be reached on Monday through Thursday, 8:00-6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on 571-272-3795. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

cc
Carl Colin
Patent Examiner
November 30, 2005

Carl
Primary Examiner
AU2131
12/1/05